

REMARKS

Claims 1-48, and 52-99 were previously pending in this application. By this amendment, Applicant cancels claim 2 without prejudice or disclaimer, and amends claims 1, 10, 12, 23, 46, 48, and 76. Therefore, claims 1, 3-48 and 52-99 are pending in the application, with claims 3, 4, 9, 13-15, 17-20, 24-45, 49-51, 53-75, and 79-99 being withdrawn from consideration. As a result claims 1, 5-8, 10-12, 16, 21-23, 46-48, 52, and 76-78 are pending for examination with claims 1, 23, 46, and 76 being independent claims. No new matter has been added.

Allowable Subject Matter

Applicants thank the Examiner for indicating the allowability of claim 2 if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph. Applicants have incorporated the limitations of claim 2 into claim 46. Allowance of claim 46, as well as claims 5-8, 10-12, 16, 22, 47, and 48 which depend from claim 46, is respectfully requested.

Interview

Applicants thank the Examiner for courtesies extended during the telephone interview of December 2, 2003 with Applicants' attorneys Robert Hunt and Geri Zollinger. The contents of the telephone interview are discussed in detail below.

Information Disclosure Statements

The Office Action indicated that the Information Disclosure Statements submitted on December 10, 2001, January 14, 2002, February 1, 2002, February 16, 2002, and May 23, 2002 have not been considered because there were an excessive number of references cited. Applicants respectfully submit that there is no limit to the number of references an Applicant can cite. On the contrary, MPEP 609 states that "once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information." Applicants respectfully submit that the cited Information Disclosure Statements met the requirements of 37 CFR 1.97 and 1.98.

Nonetheless, as discussed in the telephone interview, Applicants have listed herein some of the references from the previously cited Information Disclosure Statements which the

Examiner may find relevant to the present application. Applicants have not provided additional printed copies of the references cited below because Applicants have submitted copies of these references in conjunction with previously submitted Information Disclosure Statements for the present application.

Applicants furthermore respectfully submit that the references cited in the prior Information Disclosure Statements were cited because they may be relevant to the present application for a variety of reasons. Applicants submit that the references disclosed in previously submitted Information Disclosure Statements which are not contained in the list below may be relevant to the present application. Applicants make no representation that the references cited here are the only relevant references, or even the most relevant references.

US Patent No.	Inventor(s)	Issue date
2188080	Grimm	01-23-1940
2206035	Hammond	07-02-1940
3343847	Christy	09-26-1967
3782744	Milovich et al.	01-01-1974
3782745	Stoveken	01-01-1974
3797839	Smolka et al.	03-19-1974
3862766	Bogdanovich	01-28-1975
4116455	Dotson et al.	09-26-1978
4141570	Sudmeier	02-27-1979
4161324	Colvin	07-17-1979
4163565	Weber	08-07-1979
4165091	Chadwick	08-21-1979
4175759	Strunk	11-27-1979
4678200	Powell	07-07-1987
4784233	Favors	11-15-1988
4848781	Dykema et al.	07-18-1989
5018760	Remondet	05-28-1991

Patent number	Inventor(s)	Publication date	English translation
FR2428452	Laval et al.	01-11-1980	x

Other references
bideck.com website
sno-sk8.com website

Rejections Under 35 U.S.C. §112

The Office Action rejected claim 48 under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Specifically, the Office Action stated that the specification is not enabling for a device wherein the upturned end contacts the deck. Applicants have amended claim 48 to state that one end of the runner may be constructed and arranged to contact the deck while the device is being ridden. Sufficient enablement for this is provided by the specification, for example on page 6, lines 16-20.

The Office Action rejected claim 12 under 35 U.S.C. §112, second paragraph as being indefinite. In particular, the Office Action indicated that the phrase “the first and second upturned ends of the runner” lacked antecedent basis. Applicants have therefore amended claims 12 and 46 to overcome this rejection.

The Office Action also rejected claim 48 under 35 U.S.C. §112, second paragraph as being indefinite because it is not clear how or where the upturned end contacts the deck. Applicants have amended claim 48 to overcome this rejection.

The Office Action apparently rejected at least claims 1, 2, 5-8, 10-11, 16, 21-23, 46-47, 52, and 76-78 under 35 U.S.C. §112, second paragraph for reciting a rider as an element of the claim. Applicants have amended claims 1, 23, 46, and 76 as suggested by the Office Action to overcome this rejection.

Accordingly, withdrawal of these rejections is respectfully requested.

Rejections Under 35 U.S.C. §102 and §103

A. Claims 5-8, 10-12, 16, 22, and 46-48

The Office Action rejected claims 6, 7, 10, 11, 16, 22, 46, and 47 under 35 U.S.C. 102(b) as being anticipated by U.S. patent 4,138,128 to Criss. Additionally, claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Criss in view of Wen (U.S. patent 6,293,571). Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Criss. Without acceding to the propriety of the rejection, Applicants have amended claim 46 to include the features recited in claim 2 (which was indicated as allowable in the Office Action). Because claims 5-8, 10-12, 16, 22, 47, and 48 depend on claim 46, these claims should also be in

condition for allowance. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

B. Claims 1, 9, 13-15, 17-21, 23-45 and 52-99

The Office Action rejected claims 1, 21, 23, 76, and 78 under 35 U.S.C. 102(b) as being anticipated by U.S. patent 4,225,145 to Carr (hereinafter Carr). Claims 52 and 77 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Carr in view of Criss.

Applicants respectfully submit that Carr does not teach a “spacer secured ... so that the deck is restrained from pivoting relative to the runner about an axis running in the front to back direction” as required by independent claims 1, 23, and 76. Instead, Carr discloses a modified skateboard which includes sled runners in place of wheels. The summary of the invention section of Carr states that “[t]he present invention is a skateboard with elongated runners which may be described as continuous longitudinal blades ... *mounted on the axles of skateboard trucks*” (column 1, lines 55-58, emphasis added). A typical skateboard truck includes a baseplate that mounts the truck to the skateboard deck, an axle on which the wheels mount, and a pivot connecting the axle to the baseplate. As discussed during the telephone interview, in order to turn a skateboard, a rider leans in one direction, thus tilting the deck about its longitudinal axis relative to the axles. This causes the front and rear axles to pivot around vertical axes and allows the skateboard to turn. Likewise, in Carr the runners “pivot laterally [relative] to the longitudinal axis of the skateboard and ... warp about axes angularly related to the longitudinal axis” (column 1, lines 65-68) in response to a rider’s weight shift. Thus, a rider leans to one side to tilt the deck relative to the axles, and in response the front skateboard truck rotates about a vertical axis in one direction and the rear skateboard truck rotates about a vertical axis in the opposite direction.

The Office Action indicated that the deck of Carr is restrained from pivoting relative to the runner about an axis running in the front to back direction because the abstract states that the “[r]unners are braced to keep rails perpendicular to the top of the *board*” (last 2 lines, emphasis added). Applicants respectfully submit that this phrase in the abstract does not indicate that the deck is restrained from pivoting relative to the runner about an axis running in the front to back direction. Because it uses skateboard trucks, Carr’s design would be unable to turn if the runners

were braced to prevent the deck from pivoting relative to the runner about an axis running in the front to back direction.

As discussed during the interview, the abstract of Carr may be referring to bracing the runners perpendicular to the axle. In the summary of the invention section, Carr states that “the elongated runners are braced by two rectangular pieces which hold the elongated runners perpendicular to the skateboard” (column 1, lines 58-60, emphasis added). In the detailed description of the drawings section, Carr indicates that the braces are the pieces which hold the elongated runner when it states that “rear brace 114 [is] mounted on horizontal axle 126 and perpendicularly brac[es] elongated runner 112” (column 6, lines 38-40). However, claims 4 and 17 (the only claims directed towards the braces), state that the brace keeps the runners “perpendicular to the *axles*” (Claim 4, emphasis added) and that the brace is in “perpendicular alignment to the vehicle *axle*” (Claim 17, emphasis added). Thus, according to the claims, the brace is intended to keep the runners perpendicular to the *axles*.

Applicants therefore respectfully submit that Carr describes a skateboard apparatus with standard skateboard trucks, which require rotation of the deck about a longitudinal axis relative to the truck axles in order to turn, and does not teach restraining the deck from pivoting relative to the runner about an axis running in the front to back direction.

Accordingly, claims 1, 23, and 76, as well as claims 9, 13-15, 17-21, 24-45, 52-75 and 77-99 which depend from claims 1, 23 and 76, are allowable. Accordingly, withdrawal of the rejection of these claims is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

Serial No.: 09/733,626
Conf. No.: 2410


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Art Unit: 3611

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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